REMARKS

Claims 1-12 are pending in the application. Claims 1-12 are rejected under nonstatutory obviousness-type double patenting. Applicants address these rejections below.

I. OBVIOUSNESS-TYPE DOUBLE PATENTING:

The Examiner has rejected claims 1-12 based on nonstatutory obviousness-type double patenting citing claims 1-12 of U.S. Patent No. 6,996,124 in view of U.S. Patent No. 6,735,649. Office Action (5/3/2006), page 3. Applicants submit herewith a terminal disclaimer to overcome these rejections. Applicants note that the filing of a terminal disclaimer is not an admission of the proprietary of the non-statutory double patenting rejection. M.P.E.P. §804.02.

The Examiner has further rejected claims 1-12 based on nonstatutory obviousness-type double patenting citing claims 1-22 of U.S. Patent No. 6,735,649 in view of U.S. Patent No. 6,996,124. Office Action (5/3/2006), page 9. Applicants respectfully traverse.

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is—does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? M.P.E.P. §804. A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. §103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (C.C.P.A. 1967); M.P.E.P. §804. Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection, the factual

inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 are employed when making an obvious-type double patenting analysis. M.P.E.P. §804. However, the Examiner has not made any such inquiry. The Examiner has not made any factual inquiries (1) to determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (2) to determine the differences between the scope and content of the patent claim and the prior art as determined in (1) and the claim in the application at issue; (3) to determine the level of ordinary skill in the art; and (4) to evaluate any objective indicia of nonobviousness. M.P.E.P. §804. Any obviousness-type double patenting rejection should make clear the differences between the inventions defined by the conflicting claims—a claim in the patent compared to a claim in the application. M.P.E.P. §804. Further, any obviousness-type double patenting rejection should include reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. M.P.E.P. §804. The Examiner has not made clear the differences between the inventions claimed in the application and the claims in the cited patents. Consequently, in view of the foregoing, the Examiner has not provided a basis for an obviousness-type double patenting rejection of claims 1-12 based on U.S. Patent No. 6,735,649 in view of U.S. Patent No. 6,996,124. Thus, the rejections of claims 1-12 under obviousness-type double patenting based on U.S. Patent No. 6,735,649 in view of U.S. Patent No. 6,996,124 are improper.

In particular, the Examiner has not determined the scope and content of the patent claim relative to a claim in the application at issue but instead cites to references in the specification of multiple patents (U.S. Patent Nos. 6,735,649; and 6,996,124) as allegedly teaching various limitations in the claims in the application at issue. The disclosure of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, even where the disclosure is found in the claims. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839, 1846 (Fed. Cir. 1992). Instead, the claims of the patent are used as the basis for a double patenting rejection. *Id.* The Examiner's analysis is an improper analysis

employed in an obviousness-type double patenting rejection. As stated above, the Examiner is to first determine the scope and content of the patent claim in a single patent (claims in U.S. Patent No. 6,735,649) relative to a claim in the application at issue. That is, the Examiner is to compare each entire claim individually in a patent (U.S. Patent No. 6,735,649) relative to each claim in the application individually. In this manner, the Examiner would then be determining whether the invention defined by a claim in the patent (U.S. Patent No. 6,735,649) is merely an obviousness variation of an invention claimed in the application at issue. Thus, the rejections of claims 1-12 under obviousness-type double patenting based on U.S. Patent No. 6,735,649 in view of U.S. Patent No. 6,996,124 are improper.

As an example of the Examiner's improper analysis, the Examiner rejects claim 1 of the application at issue under obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,735,649 by citing to column 6, lines 17-18 of U.S. Patent No. 6,735,649 and further citing to column 4, lines 39-46 of U.S. Patent No. 6,996,124 for allegedly teaching the limitations of "recalculating...and adding the recalculated FCS to the stripped frame." Office Action (5/3/2006), page 9. The scope and content of claim 1 of the application at issue is not an obvious variant of claim 1 of U.S. Patent No. 6,735,649 which states the following steps:

> (a) receiving the frame; (b) storing beginning bytes of the frame in a first buffer and storing remaining bytes of the frame in a second buffer, wherein a size of the first buffer is smaller than a size of the second buffer; (c) determining the unwanted header information is stored in the first buffer; (d) copying bytes of the frame after the unwanted header information that are stored in the first buffer over a location of the unwanted header information; (e) reporting a number of bytes of the frame stored in the first buffer to be retrieved; and (f) retrieving the reported number of bytes of the frame stored in the first buffer and retrieving the bytes of the frame stored in the second buffer, wherein the storing step (b) comprises: (1) storing a destination address in the first buffer; (2) storing a source address in the first buffer; (3) storing a limited automatic repeat request (LARQ) in the first buffer; (4) storing a Q Tag in the first buffer; (5) storing a length/type in the second buffer; (6) storing a plurality of data bytes in the second buffer; and (7) storing a frame check sequence (FCS) in the second buffer.

Claim 1 of the application at issue does not contain any of these steps in the method of removing unwanted header information from a frame in a network as defined in claim 1 of U.S. Patent No. 6,735,649. The Examiner must compare all the steps of claim 1 of U.S. Patent No. 6,735,649 with claim 1 in the application at issue. *See General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839, 1843 & 1845 (Fed. Cir. 1992). How can the Examiner claim that claim 1 of the application at issue is an obvious variant of claim 1 of U.S. Patent No. 6,735,649?

Consequently, in view of the foregoing, the Examiner has not provided a basis for an obviousness-type double patenting rejection of claims 1-12 over claims 1-22 of U.S. Patent No. 6,735,649 in view of U.S. Patent No. 6,996,124. Thus, the rejections of claims 1-12 under obviousness-type double patenting based on U.S. Patent No. 6,735,649 in view of U.S. Patent No. 6,996,124 are improper.

II. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that claims 1-12 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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